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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,117	02/15/2000	Hiroyuki Yamamoto	105311	7485

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OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
ALEXANDRIA, VA 22320

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/504,117

**Applicant(s)**

YAMAMOTO, HIROYUKI

**Examiner**

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/2-15-00.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Information Disclosure Statement*

2. The reference listed in the Information Disclosure Statement submitted on 2/15/00 has been considered by the examiner (see attached PTO-1449).

### *Drawings*

3. The drawings received on 2/15/00 are acceptable by the examiner.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-24** are rejected under 35 U.S.C. 102(e) as being anticipated by Eguchi (U.S. Patent Number 6,574,670).

Regarding **claim 1**, Eguchi discloses a communication apparatus (facsimile machine F, seen in Fig. 3, or facsimile machines 41, 42, 43, seen in Fig. 4) that transmits to a receiver, image information with transmission information attached to a part of the image information, via a communication line (see abstract, column 8, lines 25 through 43, and column 10, line 63 through column 11, line 21), comprising an address inputting device that inputs address information of the receiver (column 8, lines 3 through 7, and column 10, line 63 through column 11, line 13), a setting device that sets an attachment or a non-attachment of the transmission information based on the address information (column 6, lines 52 through 67, column 8, lines 8 through 18, and column 10, line 63 through column 11, line 13), a storage device that stores the address information for which the attachment/non-attachment of the transmission information is set (RAM 8, column 5, lines 62 through 67, and column 7, lines 50 through 59), a transmission information attaching device that attaches/does not attach the transmission information to the image information, based on the address information stored in the storage device (see abstract, column 6, lines 52 through 67, column 8, lines 8 through 18, and column 10, line 63 through column 11, line 9), and a transmission device that transmits the image information with/without the transmission information attached thereto by the transmission information attaching device (see abstract, column 6, lines 35 through 67, and column 8, lines 8 through 24).

Regarding **claim 2**, Eguchi discloses the apparatus discussed above in claim 1, and further teaches that the address information includes a receiver's mail address having an account name and a domain name (see Figs. 2b, 2c, 7b, and 7c, column 7, lines 16 through 29, and column 8, line 58 through column 9, line 28).

Regarding **claim 3**, Eguchi discloses the apparatus discussed above in claim 2, and further teaches of a receiver's domain name designation device that designates the domain name of the receiver (column 7, lines 17 through 59), wherein the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted (column 6, lines 58 through 67, and column 8, lines 3 through 18), according to the conformance/non-conformance of the receiver's domain name in the address information input via the address inputting device, to the receiver's domain name designated via the receiver's domain name designation device (column 7, line 62 through column 8, line 18, and column 10, line 63 through column 11, line 21).

Regarding **claim 4**, Eguchi discloses the apparatus discussed above in claim 2, and further teaches that the communication apparatus has a transmitter's mail address having an account name and a domain name (see Figs. 2a and 7a, column 7, lines 10 through 16, and column 9, lines 4 through 10) and the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted, according to the conformance/non-conformance of the transmitter's domain name to the receiver's domain name (column 7, line 62 through column 8, line 43).

Regarding **claim 5**, Eguchi discloses the apparatus discussed above in claim 1, and further teaches of a changing device that temporarily changes the transmission information attachment/non-attachment setting made for the address information (column 7, lines 40 through 59).

Regarding **claim 6**, Eguchi discloses a communication apparatus (facsimile machine F, seen in Fig. 3, or facsimile machines 41, 42, 43, seen in Fig. 4) capable of transmitting image

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information to a receiver, via a communication line (see abstract, column 8, lines 25 through 43, and column 10, line 63 through column 11, line 21), comprising an address inputting device that inputs address information of the receiver (column 8, lines 3 through 7, and column 10, line 63 through column 11, line 13), and a transmission information attaching device that attaches the transmission information to a part of the image information (see abstract, column 6, lines 52 through 67, column 8, lines 8 through 18, and column 10, line 63 through column 11, line 9), wherein the transmission information attaching device selectively determines the attachment/non-attachment of the transmission information according to the address information (column 6, lines 52 through 67, column 8, lines 8 through 18, and column 10, line 63 through column 11, line 13).

Regarding *claim 7*, Eguchi discloses the apparatus discussed above in claim 6, and further teaches that the address information includes a receiver's mail address having an account name and a domain name (see Figs. 2b, 2c, 7b, and 7c, column 7, lines 16 through 29, and column 8, line 58 through column 9, line 28).

Regarding *claim 8*, Eguchi discloses the apparatus discussed above in claim 7, and further teaches of a receiver's domain name designation device that designates the domain name of the receiver (column 7, lines 17 through 59), wherein the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted (column 6, lines 58 through 67, and column 8, lines 3 through 18), according to the conformance/non-conformance of the receiver's domain name in the address information input via the address inputting device, to the receiver's domain name designated via the

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receiver's domain name designation device (column 7, line 62 through column 8, line 18, and column 10, line 63 through column 11, line 21).

Regarding *claim 9*, Eguchi discloses the apparatus discussed above in claim 7, and further teaches that the communication apparatus has a transmitter's mail address having an account name and a domain name (see Figs. 2a and 7a, column 7, lines 10 through 16, and column 9, lines 4 through 10) and the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted, according to the conformance/non-conformance of the transmitter's domain name to the receiver's domain name (column 7, line 62 through column 8, line 43).

Regarding *claim 10*, Eguchi discloses the apparatus discussed above in claim 6, and further teaches of a changing device that temporarily changes the transmission information attachment/non-attachment setting made for the address information (column 7, lines 40 through 59).

Regarding *claim 11*, Eguchi discloses a communication apparatus (facsimile machine F, seen in Fig. 3, or facsimile machines 41, 42, 43, seen in Fig. 4) capable of transmitting image information to a receiver, via a communication line (see abstract, column 8, lines 25 through 43, and column 10, line 63 through column 11, line 21), comprising an address inputting device that inputs address information of the receiver (column 8, lines 3 through 7, and column 10, line 63 through column 11, line 13), a setting device that sets an attachment or a non-attachment of the transmission information according to the address information (column 6, lines 52 through 67, column 8, lines 8 through 18, and column 10, line 63 through column 11, line 13), and a transmission information attaching device that attaches the transmission information to a part of

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the image information (see abstract, column 6, lines 52 through 67, column 8, lines 8 through 18, and column 10, line 63 through column 11, line 9), wherein the transmission information attaching device selectively determines the attachment/non-attachment of the transmission information based on the address information (column 6, lines 52 through 67, column 8, lines 8 through 18, and column 10, line 63 through column 11, line 13).

Regarding *claim 12*, Eguchi discloses the apparatus discussed above in claim 11, and further teaches that the address information includes a receiver's mail address having an account name and a domain name (see Figs. 2b, 2c, 7b, and 7c, column 7, lines 16 through 29, and column 8, line 58 through column 9, line 28).

Regarding *claim 13*, Eguchi discloses the apparatus discussed above in claim 11, and further teaches of a receiver's domain name designation device that designates the domain name of the receiver (column 7, lines 17 through 59), wherein the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted (column 6, lines 58 through 67, and column 8, lines 3 through 18), according to the conformance/non-conformance of the receiver's domain name in the address information input via the address inputting device, to the receiver's domain name designated via the receiver's domain name designation device (column 7, line 62 through column 8, line 18, and column 10, line 63 through column 11, line 21).

Regarding *claim 14*, Eguchi discloses the apparatus discussed above in claim 12, and further teaches that the communication apparatus has a transmitter's mail address having an account name and a domain name (see Figs. 2a and 7a, column 7, lines 10 through 16, and column 9, lines 4 through 10) and the transmission information attaching device selectively



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attaches/does not attach the transmission information to the image information to be transmitted, according to the conformance/non-conformance of the transmitter's domain name to the receiver's domain name (column 7, line 62 through column 8, line 43).

Regarding *claim 15*, Eguchi discloses the apparatus discussed above in claim 11, and further teaches of a changing device that temporarily changes the transmission information attachment/non-attachment setting made for the address information (column 7, lines 40 through 59).

Regarding *claim 16*, Eguchi discloses a communication apparatus (facsimile machine F, seen in Fig. 3, or facsimile machines 41, 42, 43, seen in Fig. 4) capable of transmitting image information to a receiver, via a communication line (see abstract, column 8, lines 25 through 43, and column 10, line 63 through column 11, line 21), comprising an address inputting device that inputs address information of the receiver (column 8, lines 3 through 7, and column 10, line 63 through column 11, line 13), a setting device that sets an attachment/non-attachment of the transmission information to the image information (column 6, lines 52 through 67, column 8, lines 8 through 18, and column 10, line 63 through column 11, line 13), a changing device that changes the transmission information attachment/nonattachment setting made by the setting device (column 7, lines 40 through 59), a transmission information attaching device that attaches/does not attach the transmission information to a part of the image information, based on the setting made by the setting device and the result of change made by the changing device (see abstract, column 6, lines 52 through 67, column 7, line 40 through column 8, line 18, and column 10, line 63 through column 11, line 9), and a transmission device that transmits to the receiver the image information, according to the address information input by the address

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inputting device (see abstract, column 6, lines 35 through 67, and column 7, line 62 through column 8, line 24).

Regarding *claim 17*, Eguchi discloses the apparatus discussed above in claim 16, and further teaches that the address information includes a receiver's mail address having an account name and a domain name (see Figs. 2b, 2c, 7b, and 7c, column 7, lines 16 through 29, and column 8, line 58 through column 9, line 28).

Regarding *claim 18*, Eguchi discloses the apparatus discussed above in claim 17, and further teaches of a receiver's domain name designation device that designates the domain name of the receiver (column 7, lines 17 through 59), wherein the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted (column 6, lines 58 through 67, and column 8, lines 3 through 18), according to the conformance/non-conformance of the receiver's domain name in the address information input via the address inputting device, to the receiver's domain name designated via the receiver's domain name designation device (column 7, line 62 through column 8, line 18, and column 10, line 63 through column 11, line 21).

Regarding *claim 19*, Eguchi discloses the apparatus discussed above in claim 17, and further teaches that the communication apparatus has a transmitter's mail address having an account name and a domain name (see Figs. 2a and 7a, column 7, lines 10 through 16, and column 9, lines 4 through 10) and the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted, according to the conformance/non-conformance of the transmitter's domain name to the receiver's domain name (column 7, line 62 through column 8, line 43).

Regarding *claim 20*, Eguchi discloses a communication apparatus (facsimile machine F, seen in Fig. 3, or facsimile machines 41, 42, 43, seen in Fig. 4) capable of transmitting image information to a receiver, via a communication line (see abstract, column 8, lines 25 through 43, and column 10, line 63 through column 11, line 21), comprising an address inputting device that inputs address information of the receiver (column 8, lines 3 through 7, and column 10, line 63 through column 11, line 13), a storage device that stores at least one piece of the receiver's address information input by the address inputting device (RAM 8, column 5, lines 62 through 67, and column 7, lines 50 through 59), a determination device that determines whether an address information of the receiver to whom the image information is transmitted, is the address information stored in the storage device or the address information newly input by the address inputting device (column 7, line 40 through column 8, line 19, and column 10, line 63 through column 11, line 13), a transmission information attaching device that attaches/does not attach the transmission information to a part of the image information, based on the determination result by the determination device (see abstract, column 6, lines 52 through 67, column 7, line 40 through column 8, line 18, and column 10, line 63 through column 11, line 9), and a transmission device that transmits to the receiver the image information, according to the receiver's address information (see abstract, column 6, lines 35 through 67, and column 7, line 62 through column 8, line 24).

Regarding *claim 21*, Eguchi discloses the apparatus discussed above in claim 20, and further teaches that the address information includes a receiver's mail address having an account name and a domain name (see Figs. 2b, 2c, 7b, and 7c, column 7, lines 16 through 29, and column 8, line 58 through column 9, line 28).

Regarding **claim 22**, Eguchi discloses the apparatus discussed above in claim 21, and further teaches of a receiver's domain name designation device that designates the domain name of the receiver (column 7, lines 17 through 59), wherein the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted (column 6, lines 58 through 67, and column 8, lines 3 through 18), according to the conformance/non-conformance of the receiver's domain name in the address information input via the address inputting device, to the receiver's domain name designated via the receiver's domain name designation device (column 7, line 62 through column 8, line 18, and column 10, line 63 through column 11, line 21).

Regarding **claim 23**, Eguchi discloses the apparatus discussed above in claim 21, and further teaches that the communication apparatus has a transmitter's mail address having an account name and a domain name (see Figs. 2a and 7a, column 7, lines 10 through 16, and column 9, lines 4 through 10) and the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted, according to the conformance/non-conformance of the transmitter's domain name to the receiver's domain name (column 7, line 62 through column 8, line 43).

Regarding **claim 24**, Eguchi discloses the apparatus discussed above in claim 20, and further teaches of a changing device that temporarily changes the transmission information attachment/non-attachment setting made for the address information (column 7, lines 40 through 59).

*Citation of Pertinent Prior Art*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Mori** (U.S. Patent Number 6,384,927) discloses a system that transmits a facsimile image as an attachment to an e-mail if a destination telephone number is registered in an e-mail address conversion table, and if the number is not registered, transmits the image as a facsimile;

**Okada et al.** (U.S. Patent Number 6,088,125) discloses a system that includes storage of domain names, whereby the system checks a domain name of a sender to determine if an error has occurred; and

**Chang et al.** (U.S. Patent Number 5,974,449) discloses a system that attaches a fax image to an e-mail message, and transmits the e-mail message to a recipient e-mail address.

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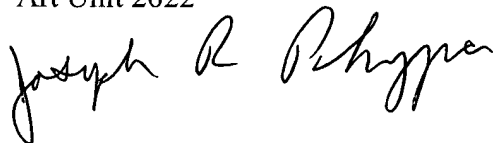
***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa  
Examiner  
Art Unit 2622



jrj